

no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation or effect...". The term "distinct" is defined in MPEP §801.02 as meaning that "two or more subjects as disclosed are related... but are capable of separate manufacture, use or sale as claimed, and ARE PATENTABLE (novel and unobvious) OVER EACH OTHER..." (emphasis in original).

The above-cited language of 35 USC §121 is clear in that the requirement to restrict an application to one of the inventions disclosed therein is proper only if the disclosed inventions are both independent and distinct. Firstly, while Applicants take no position on the patentable distinctness of Groups 12, 29, 46, and 68; Applicants submit that the claims of Groups 12, 29 46, and 68 are not independent and are so linked as to form a single general inventive concept. The lengthy explanation provided in MPEP §802.01 regarding why restriction can be properly required among independent or distinct inventions is in contradiction to the plain language of the statute and the related rules (37 CFR §1.141). Accordingly, Applicants submit that a restriction based upon the alternative use of these terms is improper.

However, even if there is a basis for the MPEP's alternative interpretation of 35 USC §121, the mere existence of two or more independent or distinct inventions in one application is not sufficient to justify a restriction requirement. According to the guidelines in MPEP §803, if "the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions."

It is submitted that the inventions of Groups 12, 29 46, and 68 as hereinabove defined, are not independent, and

although they might be classified in different classes for searching purposes, the search of the claims of these groups, including the claims for compounds, and metallopharmaceuticals or radiopharmaceuticals comprising compounds encompassed in Group 12, does not impose an undue search burden on the Examiner.

Applicants submit that an exhaustive search for the compounds of Group 12 is bound to reveal information concerning metallopharmaceuticals and radiopharmaceuticals containing these compounds (Groups 29 46, and 68). Accordingly, performing an entire search covering both the compounds and metallopharmaceuticals and radiopharmaceuticals containing them is not a serious burden on the Examiner, as opposed to separate searches, which necessarily involve duplication of searching efforts.

Applicants submit respectfully that the Examiner has provided insufficient reasons in support of a restriction between the inventions of Groups 12, 29, 46, and 68. Accordingly, Applicants respectfully request reconsideration and withdrawal of the restriction requirement between the claims encompassed by these groups.

Similarly, it is submitted that the inventions of Groups 29 46, and 68 as herein above defined, are not independent, and in fact they are classified in the same classes for searching purposes, the search of the claims of these groups, including the claims for compositions and method of use of such compositions, does not impose an undue search burden on the Examiner.

Applicants submit respectfully that the Examiner has provided insufficient reasons in support of a restriction between the inventions of Groups 29, 46, and 68. Accordingly, Applicants respectfully request reconsideration and withdrawal of the restriction requirement between the claims encompassed by these groups.

Also, since Groups 29, 46, and 68 are classified together (i.e. classified class 534, subclass 7), the MPEP § 808.02 notes that in order to establish reasons for insisting upon restriction when the subjects are classified together, ...the Examiner must show by appropriate explanation one of the following....

"(2) A separate status in the art when they are classifiable together:
Even though they are classified together, each subject can be shown to have formed a separate subject for inventive effort when an explanation indicates a recognition of separate inventive effort by inventors.
Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.

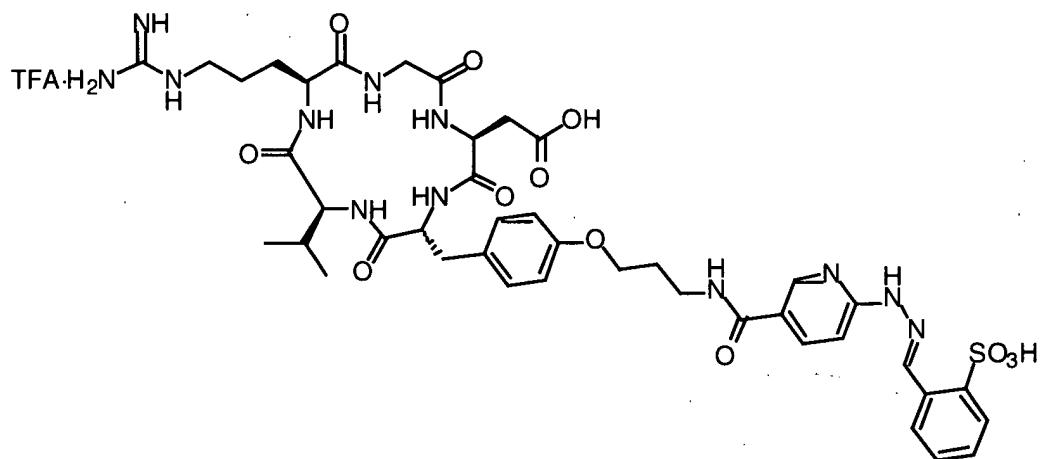
(3) A different field of search:
Where it is necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists, a different field of search is shown, even though the two are classified together...

Where, ...the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reason exists for dividing among related inventions." (Emphasis added)

Applicants assert that the Examiner has failed to show, by appropriate explanation, either of these requirements. Therefore, Groups 29, 46, and 68 should not be divided up.

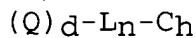
However, in order to comply with the Examiner's restriction requirement, Applicants provisionally elect, with traverse, Group 12.

As requested by the Examiner, Applicant elects Example 1 on page 92, cyclo{Arg-Gly-Asp-D-Tyr(N-[2-[[[5-[carbonyl]-2-pyridinyl]hydrazono]methyl]-benzenesulfonic acid]-3-aminopropyl)-Val}, of formula:

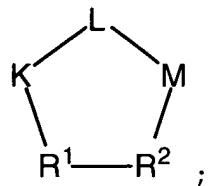


Also, as requested by the Examiner, Applicants assign each variable the appropriate value as a representative example of the species:

A compound of the formula:



wherein, Q is a peptide of the formula:



K is the L-amino acid arginine;

L is glycine;

M is L-aspartic acid;

R¹ is L-valine;

R² is tyrosine substituted with 1 bond to L_n;

d is 1;

L_n is a linking group having the formula:

$$(CR^6R^7)g - (W)h - (CR^{6a}R^{7a})g' - (Z)k - (W)h' - (CR^8R^9)g'' - (W)h'' - (CR^{8a}R^9)^a)g'',$$

W is NH;

R⁶ and R⁷ are independently selected at each occurrence from the group: H and a bond to Ch;

k is 0;

h is 1;

h' is 0;

h'' is 0;

g is 3;

g' is 0;

g'' is 0;

g''' is 0;

s is 0;

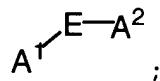
s' is 0;

s'' is 0;

t is 0;

t' is 0;

C_h is a metal bonding unit having a formula:



A¹ and A² are independently selected at each occurrence from the group NR¹³R¹⁴ and a bond to L_n;

E is a bond;

R¹³, and R¹⁴ are each independently selected from the group: hydrogen, heterocyclo-C₁alkyl substituted with 2 R¹⁷, wherein the heterocyclo group is a 6 membered heterocyclic ring system containing 1- N heteroatom;

alternatively, R¹³ and R¹⁴ combine to form =C(R²⁰)(R²¹);

R¹⁷ is independently selected at each occurrence from the group: a bond to L_n, and =O;

R²⁰ and R²¹ are independently selected from the group: H, aryl substituted with 1 R²³;

R²³ is R²⁴;

R²⁴ is -SO₃H; and,

and a pharmaceutically acceptable salt thereof.

Furthermore, Applicants affirm their right to file one or more divisional applications with respect to any of the non-elected subject matter.

Respectfully submitted,



Dated: February 19 2002

Peter L. Dolan, Ph.D.
Agent for Applicants
Registration No. 46,307